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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 347

IN THE MATTER
of the
APPLICATION OF FREDERICK C. FOSTER,
Petitioner

REPLY BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

EDWARD S. IRONS
1000 Connecticut Ave., N.W.
Washington, D. C. 20036
Attorney for Petitioner

Of Counsel:

STANLEY M. CLARK,
c/o The Firestone Tire & Rubber Company,
1200 Firestone Parkway
Akron, Ohio

MARY HELEN SEARS
1000 Connecticut Avenue, N.W.
Washington, D. C. 20036

The Daily Record Co., Baltimore, Md. 21203

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I. INTRODUCTION

The Court of Customs and Patent Appeals, since its inception, has enjoyed unique freedom from guidance by this Court on patent matters.[1]

This petition and the decision on which it rests demonstrate *prima facie* the alarming consequences of the de-

[1] The first case from the Court of Customs and Patent Appeals involving patent issues ever accepted by this Court is No. 58 this term, *Brenner v. Manson* (Br. 5).

There can be no legitimate doubt concerning the existence of certiorari jurisdiction in this case under 28 U.S.C. 1256. Respondent properly suggests "that jurisdiction does exist" (Br. 5). The Respondent in No. 58 does not dispute the existence of jurisdiction over a petition filed in this Court by the patent *applicant*.

In view of the nature and importance of the issues presented by this petition, it is respectfully suggested, if review is granted, that disposition on the merits should be generally concurrent with the other pending cases involving section 103.

velopment of this essentially autonomous authority within the patent system.[2] The court below today is hopelessly and irreconcilably locked in internal conflict (Pet. 28-34).[3] By its decision in this case, such court has placed itself at odds with virtually every relevant decision of this Court (Pet. 21-28). In defiance of both precedent and the controlling statutes — and even of its own jurisdictional limits — it has set itself up as an arbiter of "policy" whereby its decisions ignore the requirements of procedural due process (Pet. 35-40) to give effect to prevailing notions of its own majority concerning what the patent laws *should* say rather than what they *do* say — and in the process it has rendered 35 U.S.C. 103, one of the "major changes or innovations" (Pet. 18) in the 1952 Act, an admitted redundancy (Br. 8-9, Note 6) in view of the recodification in section 102 of the antecedent statutory law (R.S. 4886) (Pet. 21-23).

II. THE DECISION BELOW IS INCONSISTENT WITH THE LEGISLATIVE HISTORY AND PURPOSE OF BOTH SECTION 102 AND SECTION 103

Respondent asserts that "The result reached below is also supported by the history of the Act" (Br. 7).

The admitted redundancy (Br. 8-9, Note 6) of sections 102(a) and (b) with section 103, implicit in the decision below, is flatly inconsistent with the legislative history of both statutes.

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[2] This situation is aggravated by the circumstance that the Patent Office follows and applies the decisions of the Court of Customs and Patent Appeals in preference to those of any other court.

[3] "Pet." refers to the Petition. "Br." refers to the "Brief of the Commissioner in Opposition" to the Petition. "App." refers to the Appendix filed separately with the Petition.

Emphasis appearing in the quotations in the brief is all added emphasis unless otherwise indicated.

35 U.S.C. 102(a) and (b) are a *recodification*, without change, of the pertinent paragraphs of the *old statute*, R.S. 4886 (Pet. 16-17).

Section 103 is a *new* statute codifying *decisional* law (Pet. 18).

If its substance had been implicit in the portion of R.S. 4886 now recodified in sections 102(a) and (b), as the opinion below (App. 19a) and Respondent (Br. 8-9, Note 6) urge, there would have been no reason for section 103. Far from being a "new statute" constituting one of the two acknowledged "major changes or innovations" in the 1952 Patent Act, it would have been an exercise in Congressional futility (Pet. 16-20).[4]

35 U.S.C. 102(b), which recodified a part of R.S. 4886, is concerned with *novelty*.

The *new* section 103 is *not* concerned with *novelty* but, as the title to that statute states, with "nonobvious subject matter".

These *separate* "novelty" and "obviousness" statutes foreclose patentability on mutually exclusive grounds. Section 102 is concerned *solely* with printed publications in which the invention is "described". Section 103 is concerned *solely* with printed publications (and other forms of prior

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[4] The court below was forced to find that the antecedent statute R. S. 4886 contemplated obviousness situations in view of the unqualified and repeated statements in the legislative history that the intent of Congress in the enactment of section 102(b) was merely to recodify the prior act without change (Pet. 16-17). Respondent, faced with the same dilemma, makes the same argument — and with equal lack of authority (Br. 8-9, Note 6).

Hall v. MacNeale, 107 U.S. 90, 96, and *Smith & Griggs Mfg. Co. v. Sprague*, 123 U.S. 249 (Br. 7, Note 5) are inapposite. The result reached in both of these cases rests upon the finding that "the invention" had been in public use for more than two years prior to the date of the application for patent.

art) in which "the invention is *not . . . described as set forth in section 102*".

This *express* distinction between the "novelty" and "obviousness" statutes, *obliterated by the decision below,* is consistent with and required by the antecedent law which the statutes codified.

The ensuing table delineates the *separate* development of the requirements for novelty and unobviousness beginning with the Patent Act of 1836. As the table clearly reflects, the distinction expressed on the face of sections 102 and 103 has been observed throughout the years.

The table demonstrates that "the time-bar provisions" were never, prior to the decision in this case, applied to "obviousness" situations. Prior to the decision below, obviousness was always determined as of the "time the invention was made," just as now required by 35 U.S.C. 103.

The emasculation of section 103 for the alleged reason that it fails to serve the "purpose" of the totally distinct novelty statute (Br. 7) "with which section 103 per se has nothing whatever to do" (App. 22a) cannot be justified.

PRINTED PUBLICATIONS

AS DEFENSES BASED ON LACK OF NOVELTY	AS DEFENSES BASED ON OBVIOUSNESS
1836-1870	**1836-1870**
Act of July 4, 1836 (Section 5) provided that subject matter, to be patentable, must have been "not known or used by others before [the patentee's] discovery or invention thereof."	From 1836 to 1850 the lower courts invalidated patents on the ground that they constituted "no invention" or would have been "obvious to one of ordinary skill in the art" at the time the in-

vention was made. See for example, the decisions cited in the argument of counsel for Greenwood in *Hotchkiss v. Greenwood*, 52 U.S. (11 How.) 248, 13 L. Ed. 683, 688-689 (1850). A further example appears in Mr. Justice Nelson's majority opinion in the same case where he presided in the District of Connecticut concerning an alleged "improvement in manufacturing buttons." The principle was ratified by the Supreme Court in *Hotchkiss v. Greenwood, supra.* From that date onward, this judicial doctrine was continuously and consistently applied to negate patentability of subject matter "obvious to one of ordinary skill in the art . . . at the time the invention was made."

1870-1897

Act of 1870; pertinent section recodified without change in 1874 as R.S. 4886, which provided that subject matter to be patentable must not have been "*de-*

1870-1897

Judicial doctrine continued unchanged. The Supreme Court recognized "obviousness" as "*a valid defense not given by the statute*" and phrased the question invol-

scribed in any printed publication in this or any foreign country, before [the patentee's] invention or discovery thereof. . . ."

ved as "whether the thing patented amounts to a patentable invention", *Mahn v. Harwood,* 112 U.S. 354, 358, 28 L. Ed. 665, 667, 5 S. Ct. 174 (1884). ". . . Proof that there is no invention or discovery strikes at the root of the whole claim. The patent is based on an affirmative fact, of which this is a direct negative. It *needed no statute to aid or justify this defense. . . .*" *Reckendorfer v. Faber,* 92 U.S. 347, 354, 23 L. Ed. 719, 723 (1876).[5]

1897-1939

R.S. 4886, as amended, provided that the patented subject matter must not have been "described in any printed publication in this or any foreign country, before [the patentee's] invention or discovery thereof, or more than two years prior to his application. . . ."

1897-1939

The judicial doctrine continued unchanged. This Court continued to recognize that the relevant time was the time the invention was made. *Concrete Appliances Co. v. Gomery,* 269 U.S. 177, 180, 70 L. Ed. 222, 225, 46 S. Ct. 42 (1925), and other cases cited at Pet. 25.

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[5] Any implication in the Commissioner's Brief (Br. 8, 9 and Note 6) that "obviousness" was "implicit in the [novelty] statute" since 1850 is in the teeth of the Court's pronouncements in *Mahn* and *Reckendorfer.* It is also contrary to the plain language of sections 102(a) and (b) and 103 (Pet. 16-21).

1939-1952	1939-1952
R.S. 4886 amended to reduce the "two year" bar to "one year."	Judicial doctrine continued unchanged.
January 1, 1953 to Present R.S. 4886 recodified, without change, in pertinent portion, as 35 U.S.C. 102(a) and (b).	**January 1, 1953 to Present** Judicial doctrine, unchanged, codified as 35 U.S.C. 103.
"Paragraphs (a) [and] (b) are based on . . . R.S. 4886 . . . "No change is made in these paragraphs other than that due to division into lettered paragraphs." Reviser's Note, 35 U.S.C. 102.	"Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but *only by reason of decisions of the courts. . . .*" Senate Report No. 1979, 82nd Congress, 2nd Session, page 6; House Report No. 1923, 82nd Congress, 2nd Session, page 7.
"Section 102 in paragraphs (a), (b), . . . *repeats the conditions in the existing law relating to* novelty." Senate Report No. 1979, p. 5.	"The question of patentable invention depends upon the prior art existing at the invention date of the patent in suit. . . ." *Helene Curtis Industries v. Sales Affiliates*, 233 F. 2d 148, 155 (2 Cir. 1956).

III. THE DECISION BELOW CANNOT BE JUSTIFIED ON "POLICY" GROUNDS

Respondent's argument that the decision below which overturns a century of settled law to merge sections 102(a) and (b) with section 103 is justifiable on "policy" grounds overlooks the overweening policy which requires the courts to apply statutes *as enacted by the Congress.* The result below conflicts directly with the rules of statutory construction enunciated by this Court (Pet. 22). It conflicts as well with this Court's consistently expressed judgment that the patent statutes, including the "time-bar provisions" are to be construed in accordance with the express language of Congress (Pet. 26-28).[6]

IV. THE WORD "DESCRIBED" IN SECTIONS 102(a) AND (b) IS NOT SYNONYMOUS WITH "IDENTICAL DISCLOSURE"

Respondent and the court below seek to justify the emasculation of section 103 by a contrived interpretation of the word "described" in the novelty statute, section 102(b), to require that the "precise" (Br. 6) invention be

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[6] In addition to the cases cited in the petition, these cases include *Andrews v. Hovey,* 124 U.S. 694, 31 L. Ed. 557, 8 S. Ct. 676 (1888) and *Bate Refrigerating Co. v. Sulzberger,* 157 U.S. 1, 39 L. Ed. 601, 15 S. Ct. 508 (1895). In the latter case the Court, refusing to substitute the "policy of the government" for the words of the statute, held:

> "In our judgment the language used is so plain and unambiguous that a refusal to recognize its natural, obvious meaning would be justly regarded as indicating a purpose to change the law by judicial action based upon some supposed policy of Congress. . . .
>
> * * * * * *
>
> ". . . it is not for the courts to tamper with the words of a statute, or, by a strained construction of legislative enactments, the language of which is clear and explicit, to accomplish results not contemplated by Congress. . . ." [157 U.S. at 37-38; 39 L. Ed. at 611.]

"identically" (Br. 2, 6) or "exactly" (Br. 8) disclosed in a printed publication reference "so as to totally destroy the novelty" (Br. 7).

This is an artificial issue.[7] Neither Petitioner nor Respondent so contended below. No court has so held. It is inconsistent with the position taken by Respondent in its "Brief in No. 55, O.T. 1965, *United States v. Adams*" (Br. 9).[8] This spurious issue was invented below by the majority and it is relied upon here to support the argument that the lower court's "interpretation of section 102(b)" is essential to give that statute practical effect.

In the practical application of the novelty statutes, the courts have always recognized, as did the court in the conflicting opinion in *Bros Inc. v. Browning Mfg. Co.*, 317 F. 2d 413 (8 Cir. 1963),[9] that an "invention" was "de-

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[7] The issue is wholly artificial because neither the Patent Office nor the Solicitor in his argument before the court below ever asserted that Binder "described" Petitioner's claimed invention, "identically" or otherwise. Rather, the rejection below rested upon a recognition that the Binder reference, if available at all, could only be available under section 103 because it *neither* "identically disclosed" nor "described" Petitioner's "invention" (Pet. 6, 17).

[8] In its brief in *Adams,* Respondent properly argues that section 102 is not limited to printed publications in which "the invention" is "identically disclosed". In that brief, Respondent states:

> ". . . In effect, as the tables in a 1929 treatise exemplify . . . , the art knew of a finite, interchangeable list of substances, all capable of functioning as electrodes in batteries with fluid electrolytes. Adams drew two substances from this limited list and combined them in the very way in which the list indicated they could be combined. . . . It would denigrate any meaningful standard of novelty to hold that Adams' battery was therefore 'new.' . . . the only conclusion which can be drawn . . . is that Adams 'invention was known * * * by others' and, therefore, was not 'new' within the meaning of Sections 101 and 102 of the Act." (Brief for the United States, O.T. 1965, No. 55, pp. 17-18).

[9] The decision below conflicts in principle with the decision in *Bros Inc.* In *Bros Inc.* the court held that "section 103 is not

scribed", *in the absence of "identical disclosure"*, whenever the "description" in the printed publication was

> ". . . sufficient . . . to enable one skilled in the art of constructing . . . machinery to reproduce the invention without having resort to the patent" [317 F. 2d at 416].

This Court has frequently recognized the same rationale. For example, in *American Fruit Growers v. Brogdex Co.*, 283 U.S. 1, 75 L. Ed. 801, 51 S. Ct. 328 (1931), a process for rendering fruit mold-resistant by dipping it in an aqueous solution of borax was recognized to be the same invention as, hence "described" by, a prior art process for rendering various edibles mold-resistant by dipping them in another boron-containing chemical — namely boracic acid. In invalidating the patent, this Court stated:

> ". . . It lacks *novelty*. The *substance* of its disclosures had been revealed by Bishop twenty years earlier" [283 U.S. at 14; 75 L. Ed. at 808].

The Court of Customs and Patent Appeals, both prior and subsequent to the decision in this case, has experienced no difficulty in giving practical effect to the novelty statute by the proper application of printed publications in which "the invention" is *not* "identically disclosed" — while, at the same time, recognizing that "there are *limitations* on the availability of disclosures in printed publications as bars under section 102(b)" [*Application of LeGrice*, 301 F. 2d 929, 943 (1962)]. *Application of Petering*, 301 F. 2d 676 (CCPA 1962); *Application of Sheppard*, 339 F. 2d 238 (CCPA 1964);[10] *Application of Ruschig*, 343 F. 2d 965

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intended to modify or affect the section 102(b) time bar". In *this* case, the court below held, in effect, that section 103 enlarges section 102(b) to include printed publications in which the invention is *not* "described" as section 102(b) expressly requires.

[10] A typical example is found in *Sheppard* in which Chief Judge Worley, recognizing that the doctrine of *LeGrice* applied equally to

(CCPA 1965); and *Application of Hughes*, 345 F. 2d 184 (CCPA 1965). *Cf. Application of Hassler*, 347 F. 2d 911 (CCPA 1965), Concurring opinion (App. 62a-64a).

V. THE FUNDAMENTAL CONFLICT IN THE COURT BELOW

Each of *LeGrice, Petering, Sheppard, Ruschig* and *Hughes, supra*, holds that while "identical" disclosure is of course not required, there is a *limitation* on the availability of disclosures in printed publications to defeat novelty under 35 U.S.C. 102(a) and (b) by which such references are distinguished from the larger class of printed publications competent only to show obviousness under 35 U.S.C. 103 (Pet. 28).

The decision below and the decisions in *Application of Folkers*, 344 F. 2d 967 (CCPA 1965) and *Application of Hassler*, 347 F. 2d 911 (CCPA 1965) hold exactly the contrary. Each of these cases stands for the proposition that printed publications in which "the invention" is "*not* . . . described" (35 U.S.C. 103) are, nevertheless, competent under the *novelty* statutes 102(a) and (b) which, in terms, are limited to "printed publications" in which the invention is "described."

This is a basic and fundamental conflict. It goes to the very heart of both of the statutes defining the "conditions

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section 102(a), reversed a rejection under that statute in the following language:

> ". . . The Emeleus article is not so particular and definite that, without undue experimentation, one versed in the art to which it pertains could gain possession of the claimed subject matter. Under the circumstances we feel obliged to reverse the rejection of claims 2 and 3 under 35 U.S.C. §102(a)" [339 F. 2d at 242].

Compare the failure of the Binder reference in this case to teach or suggest any procedure by which Petitioner's "new kind of synthetic rubber" (Br. 4) could be achieved.

for patentability." Its importance far transcends the mere interpretation of the time bar provisions of section 102(b) (Br. 9, Note 7).

Resolution of this basic conflict at this time is fundamental to the efficient administration of the court below and of the Patent Office which looks to it for guidance.

VI. SECTION 103 DID NOT LOWER THE STANDARD OF INVENTION

Respondent recognizes that ". . . under the construction below, Section 103 would not limit the standard of patentability beyond the [novelty] limitation already incorporated in Section 102(a)" (Br. 8-9, Note 6). To justify this constitutionally proscribed result, Respondent seems to imply that its own brief in No. 55 urges that Congress intended to lower the pre-existing "standard of invention" by the enactment of section 103. Petitioner does not understand the Brief of the United States in that case to so contend. Rather, the brief seems clearly to insist that the standard has not been changed — a conclusion which is indeed compelled by any thorough and unbiased examination of *authoritative* precedent, legislative history and the statute itself. A contrary expression from the United States would be in the teeth of the position taken in its Petition for Writ of Certiorari in No. 55.

VII. PROCEDURAL DUE PROCESS QUESTION TWO

Petitioner was *not* notified of the "reasons" for the "rejections" of his claims applied by the Court of Customs and Patent Appeals (Pet. 35-40).

The Patent Office Solicitor advanced *two separate* rejections based on *two separate* portions, "Disclosure A" and "Disclosure B", of the Binder reference. These rejections

were *separately* characterized as "The Rejection Under Section 103" based on "Disclosure A" and "The Rejection Under Section 102" based on "Disclosure B" (Pet. 6).

"The Rejection Under Section 102" based on "Disclosure B" was reversed (Pet. 6, App. 13a). It is not before this Court.

In rejecting Petitioner's claims on the very same "Disclosure A" which the Solicitor stated was "the basis of the rejection of the claims predicated on section 103" (Pet. 6), the majority below said:

> "We wish to make it clear that this rejection is predicated on our construction of section 102(b) . . . ". . . with which section 103 per se has nothing whatever to do" (App. 22a).[11]

The court's entry of this *new* rejection, of which Petitioner was never notified and to which Petitioner has never been afforded an opportunity for response, is not only an obvious violation of procedural due process under 35 U.S.C. 132.[12] It is an excess of the court's own statutory jurisdiction under 35 U.S.C. 144 (Pet. 37-39).

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[11] The suggestion in Respondent's brief that the court below "found the statements of rejection by the Patent Office sufficient to warrant consideration of both a Section 103 and a Section 102(b) rejection" (Br. 9) is a mere reiteration of the court's own self-serving attempted justification for its entry of a new rejection (Pet. 12-13, Note 10). It cannot change the facts that Petitioner was *neither* notified of, *nor* given any opportunity to respond to, the reasons for the rejection of his claims.

[12] The court below, in *Application of Hughes*, 345 F. 2d 184, 186 (1965), decided *after* this case, pointed out with respect to sections 102 and 103 that "the issues arising under the two sections may be vastly different, and may call for the production and introduction of quite different types of evidence" (Pet. 38). 35 U.S.C. 132 requires notice sufficient to apprise the applicant concerning "the issues" (*Cf.* Br. 9).

VIII. CONCLUSION

This Petition for Writ of Certiorari should be granted.

Respectfully submitted,

EDWARD S. IRONS
1000 Connecticut Ave., N.W.
Washington, D. C. 20036
Attorney for Petitioner

Of Counsel:

STANLEY M. CLARK
c/o The Firestone Tire & Rubber Company
1200 Firestone Parkway
Akron, Ohio

MARY HELEN SEARS
1000 Connecticut Avenue, N.W.
Washington, D. C. 20036